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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
PASS, NATALIE	

ART UNIT	PAPER NUMBER
3626	

DATE MAILED: 10/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/603,306	WOLFE, BRIAN	
	Examiner	Art Unit	
	Natalie A. Pass	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 June 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4,6-9,11-25,27-39,41-46 and 58-61* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4,6-9,11-25,27-39,41-46 and 58-61* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *24 July 2006*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed 5 June 2006. Claims 1, 17, and 31 have been amended. Claims 5, 10, 26, 40, 47-57, and 62-63 have been previously cancelled. Claims 1-4, 6-9, 11-25, 27-39, 41-46, 58-61 remain pending. The IDS statement filed 24 July 2006 has been entered and considered.

Claim Objections

2. The objection to claim 21 because of informalities is hereby withdrawn due to the amendment filed 5 June 2006.

Claim Rejections - 35 USC § 112

3. The rejection of claims 1, 31 under 35 U.S.C. 112, second paragraph is hereby withdrawn due to the amendment filed 5 June 2006.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-4, 9, 14, 16-21, 25, 30-35, 39, 44, 46, 58, 60-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huffman, U.S. Patent Number 5, 870, 711 in view of Kuwamoto et al, U.S. Patent Number 5, 483, 632 and Provost, U.S. Patent Number 6, 341, 265 for substantially the same reasons given in the previous Office Action (paper number 12072005). Further reasons appear hereinbelow.

(A) Claim 1 has been amended to recite the limitations

- "to the user along with one or more of the displayed processing steps," in lines 25-26;
- "receives input from the user relating to the insurance claim," in line 30;
- "based on input from the user," in line 32; and
- "displays the estimated value to the user," in line 35.

As per these newly added limitations, Huffman, Kuwamoto and Provost teach a method as analyzed and discussed in the previous Office Action (paper number 12072005), further comprising

automatically displays the matching message text corresponding to the requested message code to the user along with one or more of the displayed processing steps (Huffman; Figure 5, Figure 6, Figure 7, column 4, lines 5-6, column 7, lines 7-20, column 11, lines 37-66, column 12, lines 50-53);

receives input from the user relating to the insurance claim (Huffman; Figure 6, Figure 7, column 4, line 65 to column 5, line 13), (Provost; Figure 3);

automatically estimates a bodily injury general damages value of the insurance claim based on input from the user (Provost; column 3, lines 55-62, column 4, lines 38-50, column 6, lines 22-26, column 9, lines 35-42); and

displays the estimated value to the user (Provost; column 11, lines 19-25.

The remainder of claim 1 is rejected for the same reasons given in the prior Office Action (paper number 12072005, section 7, pages 3-8), and incorporated herein.

The motivations for combining the respective teachings of Huffman, Kuwamoto, and Provost are as given in the rejection of claim 1 in the prior Office Action (paper number 12072005), and incorporated herein.

(B) Claim 17 differs from method claim 1, in that it is a system rather than a method for processing an insurance claim.

Amended system claim 17 repeats the subject matter of claims 1, respectively, as a set of elements rather than a series of steps. As the underlying processes of claim 1 have been shown to be fully disclosed by the collective teachings of Huffman, Kuwamoto, and Provost in the above rejection of claim 1, it is readily apparent that the system disclosed collectively by Huffman, Kuwamoto, and Provost includes the apparatus to perform these functions. As such, these limitations are rejected for the same reasons given above for method claim 1, and incorporated herein.

The motivations for combining the respective teachings of Huffman, Kuwamoto, and Provost are as given in the rejection of claim 1 in the prior Office Action (paper number 12072005), and incorporated herein.

(C) Amended claim 31 differs from method claim 1 by reciting a "carrier readable medium comprising program instructions..." in the preamble. As per this limitation, Huffman clearly discloses his invention to be implemented on a "carrier readable medium comprising program instructions" (Huffman; column 4, lines 24-35). The remainder of claim 31 repeats the limitations of claim 1, respectively, and is therefore rejected for the same reasons given above for method claim 1, and incorporated herein.

The motivations for combining the respective teachings of Huffman, Kuwamoto, and Provost are as given in the rejection of claim 1 in the prior Office Action (paper number 12072005), and incorporated herein.

(D) Claims 2-4, 9, 14, 16, 18-21, 25, 30, 32-35, 39, 44, 46, 58, 60-61 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 12072005, section 7, pages 8-12), and incorporated herein.

6. Claims 11-13, 15, 27-29, 41-43, 45, 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huffman, U.S. Patent Number 5, 870, 711, Kuwamoto et al, U.S. Patent Number 5, 483, 632 and Provost, U.S. Patent Number 6, 341, 265, as applied to claims 1, 17, and 31 above, and further in view of Ertel, U.S. Patent Number 5, 307, 262 for substantially the same reasons given in the previous Office Action (paper number 12072005). Further reasons appear hereinbelow.

(A) Claims 11-13, 15, 27-29, 41-43, 45, 59 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 12072005, section 8, pages 13-15), and incorporated herein.

7. Claims 6, 22, 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huffman, U.S. Patent Number 5, 870, 711, Kuwamoto et al, U.S. Patent Number 5, 483, 632 and Provost, U.S. Patent Number 6, 341, 265, as applied to claims 1, 17, and 31 above, and further in view of Winans, U.S. Patent Number 5, 307, 265 for substantially the same reasons given in the previous Office Action (paper number 12072005). Further reasons appear hereinbelow.

(A) Claims 6, 22, 36 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 12072005, section 9, pages 15-16), and incorporated herein.

8. Claims 7-8, 23-24, 37-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huffman, U.S. Patent Number 5, 870, 711, Kuwamoto et al, U.S. Patent Number 5, 483, 632 and Provost, U.S. Patent Number 6, 341, 265, as applied to claims 1, 17, and 31 above, and further in view of McGauley, U.S. Patent Number 5, 899, 998 or substantially the same reasons given in the previous Office Action (paper number 12072005). Further reasons appear hereinbelow.

(A) Claims 7-8, 23-24, 37-38 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 12072005, section 10, page 16), and incorporated herein.

Response to Arguments

9. Applicant's arguments filed 5 June 2006 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 5 June 2006.

(A) At pages 14-19 of the 5 June 2006 amendment, Applicant apparently argues that the features in the Application are not taught or suggested by the applied references. In response, all of the limitations which Applicant disputes as missing in the applied references, including the newly added features in the 5 June 2006 amendment, have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the collective teachings of Huffman, Kuwamoto, Provost, Ertel, Winans, and McGauley, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the remarks and explanations given in the previous Office Action (paper number 12072005) and in the preceding sections of the present Office Action, and incorporated herein.

In particular, Examiner notes that the recited features of "automatically generates a request to display a message to the user based on the displayed processing steps, wherein the request comprises a requested message code" are taught by the combination of applied references. Examiner interprets Huffman's teachings of "[f]rom the desktop workstation ... [...] the "adjuster" [reads on "user"] can review the details of a claim folder [reads on displayed to the user]" (Huffman; column 7, lines 5-20) together with Huffman's teaching of a displayed

"error message" area within "an embodiment of the user interface screen provided when accessing the AMS subsystem" (Huffman; Figure 6, column 4, lines 5-6) as teaching this limitation.

In response to Applicant's argument in the first paragraph on page 16 of the 5 June 2006 amendment that "Huffman's software are messages ... [...] ... not displayed to a user processing an insurance claim to produce an estimate of the claim," (emphasis added), Examiner respectfully notes that this is not a claimed limitation.

In response to Applicant's argument in the second paragraph on page 16 of the 5 June 2006 amendment that Huffman fails to teach "automatically displaying the matching message text for a requested message code to the user" and in the third paragraph on page 16 that Huffman fails to teach "automatically generates a request to display a message" and "the message text is display along with one or more of the processing steps," Examiner respectfully disagrees, and notes that Huffman teaches "FIG. 6 illustrates one embodiment of an AMS subsystem interface screen that the user accesses on a computer terminal. The AMS subsystem allows the claims management system to interface with existing software programs. The AMS subsystem includes a plurality of forms and tables," (Huffman; column 11, lines 41-45) and "AMSMSG.DB is a table entitled "AMS Message Table" contained in the AMS subsystem. This table contains the message text for each AMS message for conversion to a DBASE IV record followed by broadcast via the ... [...] ... interface" (Huffman; column 11, lines 62-66), which Examiner interprets, together with Huffman's teaching of a displayed "error message" area

within "an embodiment of the user interface screen provided when accessing the AMS subsystem" (Huffman; Figure 6, column 4, lines 5-6) and "displays the adjuster activity report to the screen" (reads on "the message text is displayed along with one or more of the processing steps" (Huffman; column 11, lines 37-57, column 12, lines 50-53) as teaching these argued limitations.

In response to Applicant's argument in the second paragraph on page 17 of the 5 June 2006 amendment that the applied references fail to teach, "modifying the message text of at least one entry" in a database, Examiner respectfully disagrees. Examiner notes that one object of Kuwamoto's invention is "to provide a method and a system of help-information control whereby the help facility, in displaying a help screen always in the foreground active window of a multi-window system, is implemented so that the processing overhead on application programs is minimized, with the contents of help messages for display being readily modified in accordance with any changes in or additions to application program functions," Kuwamoto; column 2, lines 8-15). As such, Examiner interprets Kuwamoto's teachings of "modifying a help message ... reflects its executing status" (Kuwamoto; column 3, lines 50-51) (reads on "modifying the message text") of at least one entry in a database during an "initial loading program" (reads on "the installation") (Kuwamoto; Figure 4, Items 401 and 410, Figure 14, see at least Item 1431, column 2, line 60 to column 3, line 64, column 10, lines 44-45, column 5, lines 30-47) as teaching the argued limitations.

At pages 14-19 of the 5 June 2006 amendment, Applicant analyzes the applied references separately and argues each of the references individually. In response to Applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See In *re Keller,* 642 F.2d 413, 208 USPQ 871 (CCPA 1981); In *re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Moreover, the issue at hand is whether or not the prior art, when taken in combination with the knowledge of average skill in the art would put the artisan in possession of the features as claimed. With regard to this issue, the courts have held that even if a patent does not specifically disclose a particular element, said element being within the knowledge of a skilled artisan, the patent taken in combination with that knowledge, would put the artisan in possession of the claimed invention. *In re Graves,* 36 USPQ 2d 1697 (Fed. Cir. 1995). As such, Examiner notes that the combination of applied references as discussed above, and the knowledge generally available to one of ordinary skill in the art teaches an insurance claims processing system comprising the recited limitations.

Conclusion

10. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. **Any response to this final action should be mailed to:**

Box AF

Commissioner of Patents and Trademarks
Washington D.C. 20231

or faxed to: (571) 273-8300.

For formal communications, please mark
"EXPEDITED PROCEDURE".

For informal or draft communications, please label
"PROPOSED" or "DRAFT" on the front page of the
communication and do NOT sign the communication.

After Final communications should be labeled "Box AF."

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (571) 272-6774. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

13. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (571) 272-6776. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (571) 272-3600. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Natalie A. Pass

August 18, 2006

JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER